

By



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09/514,649	02/29/2000	Kiyoshi Toyoda	P19157	2077

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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/514,649

Applicant(s)

TOYODA, KIYOSHI

Examiner

CHAN S. PARK

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19,23 and 27 is/are allowed.
- 6) ☒ Claim(s) 17,18,20-22,24-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 4/27/05, and has been entered and made of record. Currently, **claims 17-35** are pending.

### *Specification*

2. The corrected or substitute Abstract of the Disclosure was received on 4/27/05. The Abstract is acceptable.

### *Allowable Subject Matter*

3. **Claims 19, 23 and 27** remain allowed.

### *Response to Arguments*

4. Upon review of the reference of Yoshida et al. U.S. Patent No. 6,801,546 (hereinafter Yoshida), which was cited in the Office Action dated 2/7/05 under 35 U.S.C. 102 (e), as being anticipating **claims 17 and 28**, the examiner notes that the reference can still be interpreted as anticipating the claims, as currently amended.

Before discussing the cited reference, it is respectfully noted that the currently amended claims 17 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. Examiner finds no disclosure supporting/explaining that the e-mail address of the predetermined management center is pre-stored. The applicant's quoted section, page 12, line 23 to page 13, line 1, does not inherently conclude that the e-mail address is pre-stored. Note that the system of Yoshida also automatically transmits to the file server (electronic mail fax machine 1-11 in col. 14, lines 25-27) based on the address stored in the image communication apparatus (electronic mail fax machine 1-2 in fig. 8). Examiner requests the applicant to precisely point out the explicit disclosure of this limitation.

Moreover, claims 17 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "pre-store" does not clearly define when the e-mail address was stored. For example, it is uncertain as to whether the address was stored before the email transmission to the management center or before the image data was received by the image communication apparatus. The applicant seems to indicate that the address is stored before the image data was received by the image communication apparatus. However, this limitation is not (1) specifically recited in the claims and (2) disclosed/taught in the specification.

Now, referring to the teaching of Yoshida, examiner finds that the image communication apparatus (electronic mail fax machine 1-2 in fig. 8) includes a memory for pre-storing an e-mail address of a predetermined management center and transmits the e-mail to the predetermined management center, based on the pre-stored e-mail address of the predetermined management center. That is, when a telephone number

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of the facsimile machine 1-13 and an email address of the electronic mail facsimile machine 1-11 are transmitted from the facsimile machine 1-17, the address must be either temporarily/permanently stored **before** the actual transmission.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the email address of the predetermined management center is not transmitted by the transmitting facsimile apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicant's arguments with respect to claims 20-22, 24-26, 30-32 and 33-35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

6. Claim 17 is objected to because of the following informalities:

Line 10, "the management center" should be -- the predetermined management center --.

Appropriate correction is required.

The following quotations of 37 CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

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7. Claim 24 is objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery. It is uncertain as to how the conversion can be done to the data that is already transmitted.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 17 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner finds no disclosure supporting/explaining that the e-mail address of the predetermined management center is pre-stored. The applicant's quoted section, page 12, line 23 to page 13, line 1, does not inherently conclude that the e-mail address is pre-stored. Note that the system of Yoshida also automatically transmits to the file server (electronic mail fax machine 1-11 in col. 14, lines 25-27) based on the address stored in the image communication apparatus (electronic mail fax machine 1-2 in fig. 8).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 17 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "pre-store" does not clearly define when the e-mail address was stored. For example, it is uncertain as to whether the address was stored before the email transmission to the management center or before the image data was received by the image communication apparatus. The applicant seems to indicate that the address is stored before the image data was received by the image communication apparatus. However, this limitation is not (1) specifically recited in the claims and (2) disclosed/taught in the specification.

10. Claims 20 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "a panel configured to input an address of a destination". If only one address/destination is inputted, it is not clearly understood as to what "independently transmit[ting] the email to each of the destination" means. Is a plurality of destination addresses inputted? Or does one address define a plurality of destinations?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 18, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida.

11. With respect to claim 17, Yoshida discloses an image communication apparatus (electronic mail fax machine 1-2 in fig. 8) comprising:

a receiver configured to receive image data from a transmitting facsimile (facsimile machine 1-17) apparatus via a public switched phone network (fig. 1);

a printer configured to print the received image data (col. 12, lines 35-36);

a memory configured to pre-store an email address of a predetermined management center (see the arguments presented above); and

a controller configured to:

convert the image data received from the transmitting facsimile apparatus into data for internet transmission (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10), the received image data being duplicated for transmitting to the predetermined management center (relay facsimile system);



attach the converted data to an e-mail (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10); and

transmit the e-mail to the predetermined management center (electronic mail fax machine 1-11 in col. 14, lines 25-27), based on the pre-stored email address of the predetermined management center, the predetermined management center managing information (relay fax information, including address information, mode information and the image data, generated/requested by the originating facsimile machine 1-17) that the image communication apparatus receives (col. 14, lines 11-17 and lines 41-46) and being further connected to the image communication apparatus via the Internet (1-6 in fig. 1), the transmitted e-mail corresponding to the printed image data as the received image data printed by the printer (col. 2, lines 10-19).

12. With respect to claim 18, Yoshida discloses the image communication apparatus according to claim 17, wherein the predetermined management center is configured to store information that the image communication apparatus receives, the information being browsed by a supervisor of the management center (col. 14, lines 11-17 and lines 41-46). Additionally, it is noted that the electronic mail fax machine 1-11 inherently stores the relay facsimile information, including address information, mode information and the image data, for the further processes (13-4 ~ 13-7 in fig. 13).

13. With respect to claim 28, arguments analogous to those presented for claim 17, are applicable.

14. With respect to claim 29, arguments analogous to those presented for claim 18, are applicable.

Claims 20, 21, 24, 25, 30, 31, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al. U.S. Patent No. 6,700,674 (hereinafter Otsuka).

15. With respect to claim 20, Otsuka discloses an image communication apparatus comprising:

- a scanner configured to scan image data (col. 14, lines 44-45);

- a panel configured to input an address of a destination (col. 13, lines 36-40); and

- a controller configured to:

- convert the scanned image data into data for Internet transmission (col. 14, lines 51-54);

- attach the converted data to an email (col. 16, lines 38-39); and

- independently transmit the email to each of the destination (receiver facsimile S658 in fig. 15) input by the panel and a management center (either mail server 65 or PC 45), the management center managing information that the image communication apparatus transmits to the destination input by the panel, and being further connected to the image communication apparatus via the Internet, the management center being distinct from the destination input by the panel (col. 14, lines 58-65 & fig. 15).

16. With respect to claim 21, Otsuka discloses the image communication apparatus according to claim 20, wherein the management center stores information that the image communication apparatus transmits to the destination, the information being browsed by a supervisor of the management center (col. 14, lines 58-65). It inherently

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stores the image data either temporarily or permanently to be viewed/browsed by the user.

17. With respect to claim 30, arguments analogous to those presented for claim 20, are applicable.

18. With respect to claim 31, arguments analogous to those presented for claim 21, are applicable.

19. With respect to claim 24, Otsuka discloses an image communication apparatus comprising:

a facsimile transmitter configured to transmit image data to a destination based on a facsimile protocol (col. 12, lines 15-21); and

an email transmitter configured to:

convert the same image data transmitted by the facsimile transmitter into data for Internet transmission (col. 14, lines 51-54);

attach the converted data to an email (col. 16, lines 38-39); and

transmit the email to a management center (either mail server 65 or PC 45), the management center managing image data that is transmitted by the facsimile transmitter, and being further connected to the image communication apparatus via the Internet, the transmitted email corresponding to the image data transmitted by the facsimile transmitter (col. 14, lines 58-65 & fig. 15).

20. With respect to claim 25, Otsuka discloses the image communication apparatus according to claim 24, wherein the management center stores image data that is

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transmitted by the facsimile transmitter, the image data being browsed by a supervisor of the management center (col. 14, lines 58-65). It inherently stores the image data either temporarily or permanently to be viewed/browsed by the user.

21. With respect to claim 33, arguments analogous to those presented for claim 24, are applicable.

22. With respect to claim 34, arguments analogous to those presented for claim 25, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka as applied to claim 20 above, and further in view of Wolf U.S. Patent No. 6,535,303.

23. With respect to claim 22, Otsuka discloses the image communication apparatus according to claim 20, but it does not disclose expressly that the controller sets a mail address of a transmission destination in a "To" field of the email and sets a mail address of the management center in a "Bcc" field of the email.

Wolf, the same field of endeavor of the facsimile transmission and broadcast art, discloses a facsimile controller for setting destination addresses in both "To" and "Bcc" fields of the e-mail for facsimile transmission (col. 6, lines 43-56).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the means for setting the destination addresses in both "To" and "Bcc" fields of the e-mail of Wolf with the facsimile apparatus of Otsuka.

The suggestion/motivation for doing so would have been to distinguish the addresses of the final destinations and to broadcast the facsimile image data using the "To" and "Bcc" fields of the e-mail.

Therefore, it would have been obvious to combine Otsuka with Wolf to obtain the invention as specified in claim 22.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka as applied to claim 30 above, and further in view of Wolf.

24. With respect to claim 32, arguments analogous to those presented for claim 22, are applicable.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka as applied to claim 24 above, and further in view of Wolf.

25. With respect to claim 26, Otsuka discloses the image communication apparatus according to claim 24, but it does not disclose expressly that the e-mail transmitter sets an email address of the management center in a "To" field of the email.

Wolf, the same field of endeavor of the facsimile transmission and broadcast art, discloses a facsimile controller for setting destination address in "To" field of the e-mail for facsimile transmission (col. 6, lines 43-56).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the means for setting the destination address in "To" field of the e-mail of Wolf with the facsimile apparatus of Otsuka.

The suggestion/motivation for doing so would have been to distinguish the addresses of the final destinations using "To" field.

Therefore, it would have been obvious to combine Otsuka with Wolf to obtain the invention as specified in claim 26.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka as applied to claim 33 above, and further in view of Wolf.

26. With respect to claim 35, arguments analogous to those presented for claim 33, are applicable.

### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
July 13, 2005

Chan S. Park  
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Art Unit 2622

  
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